

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Appl. No. : 10/725,769

Applicant(s): Stuart M. Lindsay, et al.

Filed: December 2, 2003

TC/A.U.: 2800/2878

Examiner: Tony Ko

Atty. Docket: 10060298-02

Confirmation No.: 3836

Title: FAST SCANNING STAGE FOR A SCANNING
PROBE MICROSCOPE

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action of January 27, 2009 and the Notice of Non-Compliance dated July 28, 2009, please amend the above-referenced application as follows and reconsider the application in light of the following remarks.

This paper includes (each beginning on a separate sheet):

- 1. Remarks/Discussion of Issues;**

1. REMARKS / DISCUSSION OF ISSUES

Applicants have reviewed the Notice of Non-Compliance dated July 28, 2009, and respectfully submit that the Notice is in error.

The Notice asserts that the Appeal Brief, as filed, does not comply with 37 C.F.R. §41.37(c)(1)(vii), and specifically asserts that "...The argument section must match the grounds section as each grounds corresponds to a heading within the argument section."

Section 6 of the Appeal Brief recites:

The grounds of rejection to be reviewed on appeal are whether:

- "I. Claims 1, 2, 4, 12 and 13 are properly rejected under 35 U.S.C. § 103(a) in view of *Funakubo, et al.* (Translation of JP 62105440) in view of *Watanabe, et al.* (U.S. Patent 5,371,365);
 - II. Claims 3,5 and 6 are properly rejected under 35 U.S.C. § 103(a) in view of *Funakubo, et al.* in view of *Watanabe, et al.* and *Sarkar, et al.* (US Patent 6,806,991);
 - III. Claim 7 is properly rejected under 35 U.S.C. § 103(a) in view of *Funakubo, et al.* in view of *Watanabe, et al., Sarkar, et al.* and *Pai, et al.* (US Patent 6,338,249);
 - IV. Claim 8 is properly rejected under 35 U.S.C. § 103(a) in view of *Funakubo, et al.* in view of *Watanabe, et al., Sarkar, et al.* and *Elings* (US RE 37,560);
 - V. Claims 9 and 10 are properly rejected under 35 U.S.C. § 103(a) in view of *Funakubo, et al.* in view of *Watanabe, et al., Sarkar, et al.* and *Zdbelick* (US Patent 4,906,840);
 - VI. Claim 11 is properly rejected under 35 U.S.C. § 103(a) in view of *Funakubo, et al.* in view of *Watanabe, et al.* and *Marchman* (US Patent 5,811,796); and
- Claim 15 is properly rejected under 35 U.S.C. § 103(a) in view of *Funakubo, et al.* in view of *Watanabe, et al., Sarkar, et al.* and *Ando, et al.* ("A High-Speed Atomic Force Microscope for Studying Biological Samples.")"

Section 7, the Argument section, includes subsections I.-VI., and presents Applicants' traversal of the grounds of rejection subsections I.-VI., respectively. Therefore, Applicants respectfully submit that the "Argument" subsections match

respective "Grounds" subsections. As such, Applicants respectfully submit that the Notice is in error, and respectfully request the withdrawal of the Notice of Non-Compliance.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Agilent Technologies, Inc.

/William S. Francos/
by: William S. Francos (Reg. No. 38,456)
Date: August 28, 2009

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